

## REMARKS

Claim 28 is combined with cancelled claims 31, 32, 33 and 35. Such combination should not result in any Festo-like limitations despite some thinking to the contrary.

As a result of the claim combination, the only rejections that now apply to claim 28 are those under 35 USC 103 for obviousness from the cited Koide, et al., Amako, et al., Zaroni, and Liu, et al. patents as applied to claims 33 and 35. Therefore, claim 28 is made by Jepson or improvement formulation to encompasses its cutting function more clearly, while the Zaroni patent of the combination of references that is cited for the claimed improvement of a retardation feature in the cutting apparatus does not. Therefore, the combination of references is improperly assembled for the rejection.

The terms in both the preamble describing the prior art and those elements constituting the improvement are substantive claim limitations. 37 CFR § 1.75(e). *Wells Mfg. Corp. v. Littlefuse, Inc.*, 192 USPQ 256 (7<sup>th</sup> Cir. 1976).

Also as a result of the claim combination and amendment, there are now several features of

the claimed invention in the whole invention of claim 28 from the laser cutting apparatus of the

preamble to the last combined suction mechanism. But:

It is not "features" but the subject matter of the invention "as a whole" that must be considered, 35 USC §103. That features, even distinguishing features, are "disclosed" in the prior art is alone insufficient. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 199 (Fed. Cir. 1983).

The Patent Office is in agreement.

**THE CLAIMED INVENTION AS A WHOLE MUST BE  
CONSIDERED** MPEP 2141.02 (emphasis original).

This has long been the case.

In order for one to defeat a meritorious patent it is not enough to pick out isolated features in earlier prior art patents, combine them in one particular way with hindsight acquired only for the patent under attack, and then say that no invention would have been involved in selecting those particular features and combining them in the particular way in which the patentee did. *Eversharp, Inc., et al. v. Fisher Pen Co., Inc., et al.*, 132 USPQ 423, 432 (E.D. N. Ill. D.C. 1961).

In this case, the rejections begin with the laser cutting apparatus of the Koide, et al. patent that, however, "... does not expressly teach a beam condenser ...." This isolated feature is then picked out of the Amako, et al. patent that, however, relates to laser machining, which is, at least, much broader than the claimed cutting apparatus. The fact that the condenser is desirable for one or another of the many concepts of machining is not a teaching that it is useful for the cutting concept thereof to which the claims are now limited.

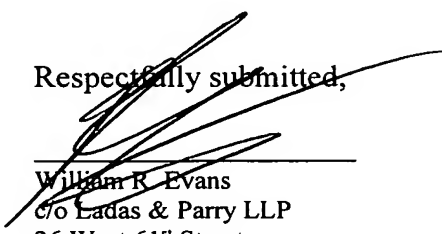
The Zanoni patent is then cited even though, as noted above, it does not relate to the now-claimed cutting apparatus. Its citation is even more problematic, however, because the obviousness is based on ensuring "... intensity and energy equalization among the two output beams ..." without showing that such intensity and energy equalization are desirable for the claimed laser cutting. What if, for example, strong and weak laser cutting channels were desired and were equalization counter to this?

The Liu, et al. patent is then cited, because "It would have been obvious ... to provide in the [cutting] apparatus of Koide et al. a debris removing means as taught by Liu, et al. ..." for scribing sapphire. While removing debris from a scribing process, which removes material to scribe, may suggest a need for debris removal, no such need is evident from the wire-cutting apparatus of Koide, et al. (see, col. 1, lines 6-9) and the claims, and none is even suggested in the Action.

Moreover, even if the wire cutting of Koide, et al. and the claims suggested debris removal, the desirability of doing so with suction, as claimed, and not washing, blowing or sweeping as also known is not shown. Therefore, this feature has been picked out of the Liu, et al. patent with hindsight only from the claims, which is not enough to defeat the meritorious patent application.

Reconsideration and allowance are, therefore, requested.

Respectfully submitted,



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